



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097533,029	03/22/00	HEARD	MB1-0010

VB

HM12/0721

KAREN J GUERRERO
MENDEL BIOTECHNOLOGY INC
21375 CABOT BOULEVARD
HAYWARD CA 94545

EXAMINER
KRUSE, D

ART UNIT	PAPER NUMBER
1638	2

DATE MAILED: 07/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/533,029

Applicant(s)

HEARD ET AL.

Examiner

David H Kruse

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 0 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. The numbering of claims is not in accordance with 37 CFR 1.126, which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 8-17 have been renumbered 7-16.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13, drawn to a transformation method and transgenic plant, classified in class 800, subclass 298 for example.
- II. Claims 14-16, drawn to a method of selecting sequences, classified in class 536, subclass 23.6 for example.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the transformation method of Invention I and the method of selecting sequences of Invention II have different starting materials, and different method steps. Invention I involves a method of transformation with a defined set of elements resulting

in a transgenic plant, and Invention II involves a method of selecting like elements. The resulting product(s) of Invention II would not necessarily be identical to that of Invention I. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, recognized divergent subject matter, and because the search required for one of the groups is not required for another, restriction for examination purposes as indicated is proper.

4. The Patent and Trademark Office recently published its policy for the examination of patent applications that claim large numbers of nucleotide sequences in the Official Gazette, 1192 O.G. 68 (November 19, 1996). Nucleotide sequences encoding different Polypeptides are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141. In establishing the new policy, the Commissioner has partially waived the requirements of 37 CFR 1.141et seq. And permit a **reasonable number of such nucleotide sequences** to be claimed in a single application. It has been determined that normally **ten sequences constitute a reasonable number** for examination purposes. Accordingly, in most cases, up to ten-(10) independent and distinct nucleotide sequences will be examined in a single application. The present application contains 121 sequences (both DNA and Polypeptide) in 19 families. These families are;

- a. WRKY (DNA Seq IDs 1,5,15,27,29,59,63,89,116,117:Polypeptide Seq IDs 2,6,16,28,30,60,64,90)
- b. NAM (DNA Seq IDs 3,23,37,73,99,115,121:Polypeptide Seq IDs 4,24,38,74,100)
- c. bZIP (DNA Seq IDs 7,13,35,41,49,53,91,103:Polypeptide Seq IDs 8,14,36,42,50,54,92,104)
- d. HB (DNA Seq IDs 9,77,97,101:Polypeptide Seq IDs 10,78,98,102)
- e. AP2 (DNA Seq IDs 11,17,21,33,65,81,95:Polypeptide Seq IDs 12,18,22,34,66,82,96)
- f. MISC (DNA Seq IDs 19,51:Polypeptide Seq IDs 20,52)
- g. HS (DNA Seq IDs 25,79:Polypeptide Seq IDs 26,80)
- h. MYB (DNA Seq IDs 31,39,57,61,67,85,87,93,111,120:Polypeptide Seq IDs 32,40,58,62,68,86,88,94,112)
- i. Z (DNA Seq IDs 43,45,119:Polypeptide Seq IDs 44,46)
- j. bZIPt2 (DNA Seq ID 47:Polypeptide Seq ID 48)
- k. AKR (DNA Seq IDs 55,118:Polypeptide Seq ID 56)
- l. CAAT (DNA Seq IDs 69,107:Polypeptide Seq IDs 70,108)
- m. AT-Hook (DNA Seq ID 71:Polypeptide Seq ID 72)
- n. IAA/ARF (DNA Seq ID 75:Polypeptide Seq ID 76)
- o. BPF-1 (DNA Seq ID 83:Polypeptide Seq ID 84)
- p. PAZ (DNA Seq ID 105:Polypeptide Seq ID 106)
- q. HLH/MYC (DNA Seq ID 109:Polypeptide Seq ID 110)

- r. GATA Zn (DNA Seq ID 113)
- s. MADS (DNA Seq ID 114).

Applicant is required to elect one family from those listed above for examination in addition to election of Invention I or Invention II.

5. Applicant is advised that the reply to this requirement to be complete within 30 days and must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, PhD whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Paula Hutzell can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4315 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1234.



AMY J. NELSON, PH.D
PRIMARY EXAMINER

David H. Kruse, PhD
19 July, 2000